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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/912,687	07/24/2001	Moshe Shoham	I0892-003-999	7153

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EXAMINER

NGUYEN, VI X

ART UNIT	PAPER NUMBER
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3731

DATE MAILED: 12/23/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/912,687	SHOHAM, MOSHE
	Examiner	Art Unit
	Victor X Nguyen	3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 25 November 2002.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-13 and 33-44 is/are pending in the application.
- 4a) Of the above claim(s) 14-32 is/are withdrawn from consideration.
- 5) Claim(s) 13 is/are allowed.
- 6) Claim(s) 1,6,8-12 and 33-44 is/are rejected.
- 7) Claim(s) 2-5 and 7 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8 . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 6, 8, 10-12 and 33-39 are rejected under 35 U.S.C. 102 (b) as being anticipated by Matsen, III et al (U.S. 5,236,432).

Matsen, III et al discloses as is claimed (Abstract, figures 3, 4, 7, 15, col. 11 lines 1-16 and lines 40-55, col. 14, lines 10-41 and col. 19 lines 5-46) a surgical system including a surgical robot (54) for manipulating a surgical tool (65, 73); an attachment member (52, 156) attached to the surgical robot (54) to a bone associated with the surgical site and a controller (55) programmed prior to the surgical procedure to direct the robot (54) at the surgical site, wherein said surgical tool (65, 73) includes at least one of a tool guide, a cutting member and a drilling member (col. 11 lines 40-55); wherein the controller (55) includes a CPU (66) and user interface communicating with the robot and said CPU (66) containing a program for guiding the robot (54) based on data generated from surgical site images; and wherein the controller (55) is further programmed with instructions for registering the surgical robot (54) with at least one pre-operative three dimensional image of a patient.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9, 40-44 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Matsen III in view of Jensen et al (5,814,038).

With respect to claims 9 and 40-41, Matsen III teaches all aspect of the claimed invention except the bone attachment portion includes a clamp. Jensen teaches the bone attachment portion includes a clamp (fig. 1, col. 1 lines 12-27, col. 3 lines 34-50 and col. 7 lines 51-64) in order to grasp and manipulate instruments efficiently under the surgeon's control. It would have been obvious to one of ordinary skill in the art at time of the invention to modify Matsen by adding the bone attachment portion includes a clamp in order to grasp and manipulate instruments efficiently under the surgeon's control.

With respect to claims 42-44, Matsen III teaches all aspect of the claimed invention except the bone attachment portion further includes locking assemblies. Jensen teaches the bone attachment portion further includes locking assemblies (figure 2a, col. 7 lines 37-67, col. 8 lines 1-22) in order to prevent the instrument can not be twisted and disengaged from the instrument support during surgery. It would have been obvious to one of ordinary skill in the art at time of the invention to modify Matsen by adding the bone attachment portion further includes locking assemblies in order to prevent the instrument can not be twisted and disengaged from the instrument support during surgery.

Allowable Subject Matter

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3. Claims 2-5 and 7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

4. Claim 13 is allowed.

5. The following is a statement of reasons for the indication of allowable subject matter:

None of the prior art of record disclose or suggest wherein two pairs of actuators extending outward from the base member at fixed angles and wherein the actuators each have first and second ends being spaced apart on the base member and the second ends of a pair coming together to define a tool holding element.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Pat. No. 5,791,231 to Cohn et al U.S. Pat. No. 5,546,942 to Zhang

U.S. Pat. No. 5,824,085 to Sahay U.S. Pat. No. 5,408,409 to Glassman

U.S. Pat. No. 5,806,518 to Mittelstadt U.S. Pat. No. 6,226,548 to Foley

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor X Nguyen whose telephone number is (703) 305-4898. The examiner can normally be reached on M-F (8-4.30 P.M.).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Milano can be reached on (703) 308-2496. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3590 for regular communications and (703) 305-3590 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

Victor X Nguyen
Examiner
Art Unit 3731

vn

December 16, 2002

KEVIN T. TRUONG
PRIMARY EXAMINER

12/16/02